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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/074,745	02/11/2002	Peter G. Schultz	220032001301	2759

7590 07/30/2002
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EXAMINER

BAKER, MAURIE GARCIA

ART UNIT PAPER NUMBER

1627

DATE MAILED: 07/30/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/074,745

Applicant(s)

Schultz et al

Examiner

Maurie Garcia Baker, Ph. D.

Art Unit

1627

– The MAILING DATE of this communication appears on the cover sheet with the correspondence address –

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ONE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Feb 11, 2002
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 94-162 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 94-162 are subject to restriction and/or election requirements.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other: _____

DETAILED ACTION

1. The Preliminary Amendment filed February 11, 2002 is acknowledged. Claims 1-93 were cancelled and claims 94-162 were added. Thus, claims 94-162 are currently pending.

2. This case is a continuation of application serial no. 09/127,195. The following species election requirement mirrors that in the parent case, with minor changes for clarity and/or based on the claims as presented in the instant case (vs. those in the parent).

Election/Restriction

3. Claims 94-162 are generic to a plurality of disclosed patentably distinct species comprising the following. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Election of a single species from *each* of the groups set forth below is required.

(A) Substrate attachment and type of substrate

- i) polymers attached to substrate
- ii) polymers unattached (but present)

Furthermore, a specific type of substrate should be elected (see e.g. claim 158)

(B) Polymer array prepared (e.g. claims 95-97, 107-111, 122, 123, 125, 126, 128, 129, 145-149)

Applicant should elect, for purposes of search, a specific species of polymer array prepared by specifying its chemical composition (the election should result in a specific species of array that has all components fully (not subgenerically) defined). The number of materials in the array should also be elected.

(C) Delivery of reagents in each group (e.g. first second, etc.)

Applicant should elect whether reagents in each are delivered simultaneously or non-simultaneously and specifically how they are delivered (gradient of stoichiometries, etc.)

(D) Polymerization control and timing

Applicant should elect whether control of polymerization is independent for each region (or not) and whether the process in each region is to be conducted simultaneously (or not)

(E) Delivery means

- i) pipette; e.g. claim 103
- ii) ink jet; e.g. claim 104

(F) Screening (e.g. claims 112, 138, 139, 140, 141, 142, 143)

- i) for a thermal property; e.g. claims 118, 154
- ii) for a mechanical property; e.g. claims 119, 155
- iii) for a morphological property; e.g. claims 120, 156
- iv) for a chemical property; e.g. claims 115, 151
- v) for an optical property; e.g. claims 113, 114, 150
- vi) for a magnetic property
- vii) for an electrical property

(G) Method of screening

- i) parallel; e.g. claims 116, 152
- ii) sequential; e.g. claims 117, 153

(H) Further pressurization (e.g. claims 159, 162)

Applicant should elect whether the array is further pressurized with a gas during polymerization (or not)

4. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made and/or in their specific steps and elements needed for carrying them out. Therefore, the species have different issues regarding patentability and represent patentably distinct subject matter.

5. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

6. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a *listing of all claims readable thereon*, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

7. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

8. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie Garcia Baker, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday from 9:30 to 7:00 and alternate Fridays.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or

proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie Garcia Baker, Ph.D.
July 29, 2002

A handwritten signature in black ink, consisting of stylized, overlapping letters that appear to be 'M' and 'B' followed by a long horizontal flourish.

MAURIE GARCIA BAKER, Ph.D.
PATENT EXAMINER